38. The hand-held display system according to claim 33, further comprising at least one operation occurring at a speed different than the processing speed for processing the video game program.

39. The hand-held display system according to claim 38, wherein the at least one operation comprises a direct memory access operation.

40. A method of setting a processing speed of a processor of a hand-held display system for playing video games, the method comprising:

processing a video game program contained on a computer-readable medium detachably connected to the hand-held display system;

determining if the video game program includes a processing speed instruction; and

if the video game program includes a processing speed instruction, setting the processing speed of the processor in accordance with that instruction.--

REMARKS

Reconsideration and allowance of the subject patent application are respectfully requested.

The specification has been amended to update the status of the parent application. Entry of this amendment is respectfully requested.

Reconsideration of the comments regarding the incorporation by reference of the priority provisional applications is respectfully requested. In particular, upon issuance of this application as a patent, the referenced priority provisional applications will in fact be available to the public. As such, the incorporation by reference of provisional application nos. 60/112.181 and 60/123,745 is believed to be proper. Applicants also note that such incorporations by reference are present in the now-issued parent application.

Applicants request acknowledgement of the priority claim to JP 10-145620 and acknowledgement of receipt of the certified copy of the priority document in parent application no. 09/321,201.

Claims 21 and 22 were rejected under 35 U.S.C. 103 as allegedly being unpatentable over Shiraishi *et al.* (U.S. Patent No. 4,981,296). Claim 21 is directed to a game program storage medium that stores clock speed data usable by a portable game machine in a process for setting a clock speed of a processor of the game machine. Claim 22 is directed to a portable storage device that stores video game instructions, wherein the instructions include a command for causing a microprocessor of a portable game machine to be set at one of a plurality of different clock speeds. This subject matter is illustratively described in the subject application at, for example, page 14, lines 9-27.

Shiraishi *et al.* discloses a data processing device in which an operator is able to change the data processing speed of a microprocessor (*i.e.,* either standard or slow speed). Figure 4 shows a set-up menu for changing the processing speed. The operator manually operates a cursor key 5a to move the cursor into a processor speed-shifting indication column 51 on the menu display.

> Next, when the operator presses the space key 5c (step S4), the CPU 1
> determines whether or not the cursor mark is present in the processor

speed-shifting column 51 (step S5). If the slow flag is ON, the CPU 1
turns it OFF (steps S6 and S7). Conversely, if the slow flag is OFF, the
CPU 1 turns it ON (steps S6 through S8). "Slow" or "Standard" message
data is then written into the video memory 6 (steps S9 and S10) so that
either of these messages can be displayed in a processor speed column
(52). After providing the needed mode, the operator then presses the set-
up key 5b, which allows the data processing system to execute the
processes matching the entered mode. Shiraishi *et al.*, col. 2, ll. 43-55.

In contrast to the claimed use of storage medium or storage device with data or

instructions to set the speed of a game machine microprocessor, Shiraishi *et al.* only

discloses operator-setting of the microprocessor processing speed. Disadvantages of such

an arrangement includes the possibility that the operator may set the speed to something

other than the most suitable speed, thereby adversely impacting video game data

processing. In contrast, the arrangements of claims 21 and 22 may be used to ensure that

the microprocessor speed is set at the most suitable speed for a particular video game.

There is no disclosure or suggestion in Shiraishi *et al.* of providing a storage medium or

storage device with data or instructions for setting the clock speed of a game machine

microprocessor. The office action alleges:

> As [Siraishi] clearly teaches manually altering processor speeds for
> use with electronic gaming systems one would have been motivated to
> include the correct processor speed with a specific game as it obvious (sic)
> to automate a manual process. Therefore, it would have been obvious to
> one of ordinary skill in the art to modify the teaching [of Shiraishi] and
> include processor speed configurations with a specific game to reduce the
> burden on a user of manually switching between processor speeds for a
> particular game. Office action, page 3.

The office action, however, cites to no evidence to support the conclusion of

obviousness. Applicants' disclosure, not Shiraishi *et al.*, provides the teaching of a

storage medium or storage device with data used to set the clock speed of a game

machine microprocessor. Applicants' disclosure cannot be used to supply the teaching

missing from the prior art. "To imbue one of ordinary skill in the art with the knowledge

of the invention, when no prior art reference or references of record convey or suggest

that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein

that which only the inventor taught is used against its teacher." *See W.L. Gore & Assoc.*

v. Garlock, Inc., 721 F.2d 1540, 1543, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

The office action also attempts to demonstrate obviousness by asserting that it is

per se obvious to automate a manual process. First, there is no evidence that the subject

matter of claims 21 and 22 constitutes the mere "automation" of the process described in

Shiraishi *et al.* Second, the reliance on such a *per se* rule is conclusory. Obviousness

within 35 Section 103 requires evidence to support such a conclusion, not merely

reference to *per se* rules.

> The use of *per se* rules, while undoubtedly less laborious than a
> searching comparison of the claimed invention - including all its
> limitations - with the teachings of the prior art, flouts section 103 and the
> fundamental case law applying it. *Per se* rules that eliminate the need for
> fact-specific analysis of claims and prior art may be administratively
> convenient for PTO examiners and the Board ... But reliance on *per se*
> rules of obviousness is legally incorrect and must cease... We once again
> hold today that our precedents do not establish any *per se* rules of
> obviousness.

In re Ochiai, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).

For at least these reasons, Applicants respectfully submit that Shiraishi *et*

al. does not render obvious the subject matter of claims 21 and 22.

New claims 25-38 have been added for the Examiner's consideration. The

subject matter of these new claims is fully supported by the original disclosure

and no new matter is added. Claims 25-28 depend from claim 21 and claims 29-

32 depend from claim 22. These claims are allowable at least by virtue of their

dependency from claims 21 and 22 and because they describe subject matter not disclosed or suggested by Shiraishi *et al.*. For example, Shiraishi *et al.* does not disclose the concepts of compatibility data or a machine identification program as set forth in various ones of these claims. Claims 33 and 40 are believed to be allowable for reasons similar to those advanced above with respect to claims 21 and 22. Claims 34-39 are believed to be allowable because of their dependency from claim 33 and because of the above-noted deficiencies of Shiraishi *et al.* with regard to compatibility data and a machine identification program.

The pending claims are believed to be in condition for allowance and early notification to that effect is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.

Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
MJS:led

<u>**Version marked to show changes made**</u>

IN THE SPECIFICATION

On page 1, the sentence inserted before line 4 by the Preliminary Amendment of

October 19, 2001 has been amended as follows:

This application is a continuation of Application No. 09/321,201, filed May 27,

1999<u>, now U.S. Patent No. 6,315,669</u>.